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10/659,228	09/10/2003	Barbara Rae Ryan	54151.19US1	3486
34018	7590	06/11/2010		EXAMINER
GREENBERG TRAURIG, LLP			RETTA, YEHDEGA	
77 WEST WACKER DRIVE			ART UNIT	PAPER NUMBER
SUITE 3100			3622	
CHICAGO, IL 60601-1732				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/659,228	<b>Applicant(s)</b> RYAN ET AL.
	<b>Examiner</b> Yehdega Retta	<b>Art Unit</b> 3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 25 March 2010.  
 2a) This action is FINAL.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 59 and 63-68 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 59 and 63-68 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/GS-68)  
     Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
     Paper No(s)/Mail Date \_\_\_\_\_
- 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

## DETAILED ACTION

This office action is in response to amendment filed March 25, 2010. Applicant amended claim 59. Claims 59 and 63-68 are currently pending.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 59, 63, 66 and 68 are rejected under 35 U.S.C. 102(e) as being anticipated by Voltmer et al. (US 7,398,225 B2).

Regarding claims 59 and 68, Voltmer teaches a distribution system to distribute a recurring cash value benefit to the consumer; *a point of sale device associated with the retail store* (located at the retail store) for accepting the distributed recurring cash value benefit (see col. 14 lines 16-67; *wherein the most-valued consumer is selected from a plurality of consumers*). Voltmer teaches the system may be used to compile, analyze and report data in a manner which would inform any or all network participants that for example a specific consumer (1) has made multiple purchases of particular manufacturers' products, (2) has spent Q dollars over a certain time period (3) at specific multiple retailers and (4) of the purchases made ... Voltmer further teaches system administrator may allocate rewards points to participants in the system (col. 10 lines 33-67). Voltmer also teaches that for example if a participating consumer buys a **product**

**from a retailer for \$ 100** and if the retailer reward ratio is one reward point for each dollar ...  
earning 100 points (see col. 12 lines 21-50).

*Examiner also would like to point out that the claim is a system claim and whether the customer is selected based on gross profit margin or not, does not change the structure or function of the distribution system to distribute cash benefit or to accept the distributed cash benefit.* It has been held that Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation (MPEP §2106 II C).

Regarding claims 63 and 66, Voltmer teaches the recurring cash value benefit has the form of a paycheck; distributing the benefit via Internet (see col. 9 lines 23-27, col. 14 lines 16-33).

**If patentable weight should be given to the claim language recited in claim 59 the rejection stated below as being anticipated by Chasko applies.**

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 59, 63, 66 and 68 are rejected under 35 U.S.C. 102(e) as being anticipated by Chasko (US 6,901,373).

Regarding claims 59 and 68, Chasko teaches a distribution system to distribute a recurring cash value benefit to the consumer (see col. 6 lines 11-38); *a point of sale device associated with the retail store* (located at the retail store) for accepting the distributed recurring cash value benefit (see col. 7 lines 1-24); *wherein the most-valued consumer is selected from a plurality of consumers based on at least one of the retail store's gross profit margin on the purchases made by individual ones of the plurality of consumers* (see fig. 3, col. 4 lines 40-55, col. 7 lines 25-55).

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 64 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Voltmer et al. (US 7,398,225 B2) in view of Sullivan (US 6,941,279 B1).

Regarding claims 64 and 65, Voltmer teaches wherein the benefit comprises of gift certificates, rebates, credit etc., but does not explicitly teach wherein the benefit is distributed on monthly or quarterly basis. Sullivan teaches a rebate calculated periodically, such as monthly or quarterly basis and a statement is issued to the cardholder which includes an entry for total accumulated rebate. Sullivan also teaches that the rebate amount is preferably transferred ...

submitting the rebate as a two-party check which can be submitted by the customer to the investment account provider (see col. 3 lines 1-47). It would have been obvious to one of ordinary skill in the art at the time of the invention to send the rebate statement of Voltmer monthly or yearly, as in Sullivan, if the rebate is calculated periodically, as taught in Sullivan.

Regarding claim 67, Voltmer does not teach distributing the benefit via an email message. Official notice is taken that is old and well known in the art of retail store, for stores to send email message to customer to inform them about the benefit. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to implement the email message in Voltmer, in order to inform the customers of the reward earned, since email is the convenient way of communication.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 63-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chasko in view of Sullivan (US 6,941,279 B1).

Regarding claims 63, 64 and 65, Chasko teaches when a customer completes purchases a reward (often in the form of coupon or rebate) or balance statement is sent to the customer (see col. 1 lines 20-40). Chasko failed to teach that the benefit has the form of a paycheck that is distributed periodically on monthly or quarterly basis. Sullivan teaches a rebate calculated

periodically, such as monthly or quarterly basis and a statement is issued to the cardholder which includes an entry for total accumulated rebate. Sullivan also teaches that the rebate amount is preferably transferred ... submitting the rebate as a two-party check which can be submitted by the customer to the investment account provider (see col. 3 lines 1-47). It would have been obvious to one of ordinary skill in the art at the time of the invention to send the rebate statement of Chasko monthly or yearly, as in Sullivan, when the rebate is calculated periodically, as taught in Sullivan.

Regarding claims 66 and 67, Chasko does not teach distributing the benefit via the Internet or via an email message. Official notice is taken that is old and well known in the art of retail store, for stores to send email message or via Internet to customer to inform them about the benefit. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to implement the email message in Chasko, in order to inform the customers of the reward earned, since email is the convenient way of communication.

#### *Response to Arguments*

Applicant's arguments with respect to claims 59 and 63-68 have been considered but are moot in view of the new ground(s) of rejection.

As indicated above the limitation "*wherein the most-valued consumer is selected from a plurality of consumers based on at least one of the retail store's gross profit margin on the purchases made by individual ones of the plurality of consumers*" on a system claim does not distinguish over the prior art based on the type of customer handled by the system. Therefore, the claimed language is nonfunctional descriptive material which cannot distinguish the invention

from the prior art. *See In re Lowry*, 32 F.3d 1579, 1582-83 (Fed. Cir. 1994). However examiner also rejected the claimed language as anticipated by Chasko, as indicated above.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YR

/Yehdega Retta/  
Primary Examiner, Art Unit 3622